

REMARKS

Claims 1-22 are pending. By this response, claim 4 is amended.

Reconsideration and allowance based on the above amendments and following remarks are respectfully requested.

The Office Action rejects claims 1, 4, 5, 11-15 and 17-22 under 35 U.S.C. §103(a) as being unpatentable over No (U.S. Patent No. 6,587,140) in view of Maeda, et al. (U.S. Patent No. 6,072,465); claims 2, 6 and 16 under 35 U.S.C. §103(a) as being unpatentable over No, Maeda and further in view of Kimura (U.S. Patent No. 5,016,223); claims 3 and 9 under 35 U.S.C. §103(a) as being unpatentable over No, Maeda in view of Kimura and Yoshimura (U.S. Patent No. 5,950,013); claim 7 under 35 U.S.C. §103(a) as being unpatentable over No, Maeda and Oda (U.S. Patent No. 5,490,117); claim 8 under 35 U.S.C. §103(a) as being unpatentable over No, Maeda, Oda and Kimura; and claim 10 under 35 U.S.C. §103(a) as being unpatentable over No, Maeda, Oda and Yoshimura. These rejections are respectfully traversed.

The Examiner alleges that No provides applicant's claimed memory card and image processing device as recited in independent claims 1, 4 and 18, except for the use of an LCD that has an opening in the back for illumination. The Examiner alleges Maeda makes up for this deficiency when combined with No. Applicant respectfully disagrees.

No provides teachings of a device such as a camera or printer that can receive a PC card 7. The PC card includes memory for storing images and a

screen for displaying the image. The PC card is connected to the device (camera, printer) by a row of input and output contacts 41 along the edge of the PC card. A receiving slot is also provided in the device to guide and secure the PC card. See column 3, lines 20-25. The PC card of No can be illuminated by the selection of a button on the PC card. See column 5, lines 43-45. The illumination of the LCD is provided by the PC card itself. The PC card is only in contact with the device through the row of contact pins whereby data is transferred. Light is not emitted from the device to provide illumination for the LCD of the PC card when the card is inserted therein.

In contrast, embodiments of the present invention provide a memory card that includes an LCD for displaying images contained in the memory. In order to keep the memory card as small as possible, the light source for illuminating the LCD is provided externally to the memory card. When the card is inserted into an image apparatus, an opening in the back of the memory card casing receives light from the image apparatus itself for illuminating the LCD.

The Examiner alleges Maeda provides a teaching of illuminating an LCD using a light source. Applicant agrees that Maeda teaches an LCD having a light source for illuminating the LCD. However, Maeda teaches a detachable large scale LCD display which is part of a computing device. Nowhere does Maeda suggest using an LCD as part of a memory card, let alone in the manner claimed by applicant.

Further, the Examiner has applied Maeda to teach illuminating an LCD from the backside. No already provides this teaching. In fact, the illumination of an LCD in this manner is an essential part of most LCD devices. However, applicant is claiming a unique method and apparatus for providing the light to the backside of an LCD of a memory card from an external source. No and Maeda each fail to teach or suggest a memory card that includes an LCD and receives light for an external source outside the memory casing from illuminating the LCD.

Moreover, applicant reminds the Examiner that there must be some motivation or suggestion within the prior art itself or by the teachings of one of ordinary skill to combine teachings. No and Maeda provide no such motivation. In fact, even if the Examiner's alleged assertions were correct, which applicant contends they are not, one of ordinary skill would not combine No's and Maeda's teachings. No teaches a memory card that includes a row of pins for receiving information and includes casing. No's memory card illuminates the LCD from inside the casing of the memory card. The external devices do not provide light to the PC card. Thus, No teaches away from the alleged teachings of Maeda. Therefore, even if Maeda's alleged teachings could be combined be with No, one of ordinary skill would not combine these teachings because No's system operates contrary to Maeda's alleged teachings.

Note that the mere fact that the references can be modified, does not render the results in combination obvious unless the prior art suggests the

desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Certainly nothing within the references suggests or motivates the modification proposed by the Examiner.

Thus, No alone or in combination with Maeda fail to teach or suggest a memory card having a transmission type display panel and an image processing apparatus comprising an electronic image receiving element, a processing circuit for processing said image for storage, a receiving area receiving said memory card and a light source underlying said receiving area for illuminating said transmissive type panel from the backside thereof, as recited in claim 1.

Further, No alone or in combination with Maeda fail to teach or suggest, *inter alia*, a case for accommodating said image memory and said liquid crystal display device, said case having an opening and a location corresponding to a backside of said liquid crystal display device for receiving light to illuminate said liquid crystal display device, said received light being emitted from said image processing apparatus when said case is inserted therein, as recited in claim 4.

Also, No alone or in combination with Maeda fail to teach or suggest, *inter alia*, using the display of the memory card as a display of the imaging device while said memory card is attached to said imaging device by illuminating said display of the memory card using said memory card illuminating device, as recited in claim 18.

Further, Kimura, Yoshimura and Oda fail to make up for the deficiencies of No and Maeda.

In view of the above, applicants respectfully submit that the references alone or in combination fail to teach each and every feature of the invention as recited in independent claims 1, 4 and 18. Further, one of ordinary skill in the art would not be motivated to combine teachings of Maeda and No to achieve any part of applicant's claimed invention. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

Conclusion

For at least these reasons, it is respectfully submitted that claims 1-22 are distinguishable over the recited art. Favorable consideration and prompt allowance are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad J. Billings (Reg. No. 48,917) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Appl. No. 09/392,445

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Michael K. Mutter, #29,680

MKM/CJB:cb
0905-0222P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s)